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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1937.

—
No. 608
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LINCOLN ENGINEERING CO. OF ILLINOIS,

Defendant-Petitioner,

vs.

STEWART-WARNER CORPORATION,

Plaintiff-Respondent.

—
**BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI.**



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OCTOBER TERM, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

vs.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

THE PETITIONER'S REAL COMPLAINT IS NOT THAT THE SEVENTH CIRCUIT COURT OF APPEALS MISUNDERSTOOD OR MISSTATED THE LAW, BUT RATHER THAT THE COURT DID NOT FIND THE FACTS TO BE WHAT THE PETITIONER ASSERTED THEM TO BE.

Not every lawsuit involves new and important questions of law. This is as true of patent infringement suits as of other kinds of suits.

In the vast majority of cases, the requisite principles of law are thoroughly well settled. The only questions involve a determination of the facts.

Every defeated litigant who hopes to secure review and a reversal in the United States Supreme Court, realizes

that this Court cannot occupy itself with the mere re-determination of the facts. It is for this reason, doubtless, that every petitioner for a writ of certiorari tries to contort his case into one which involves new and important questions of pure law.

The petition herein has to do with another patent infringement suit of that character. If the facts are what the District Court and the Seventh Circuit Court of Appeals found them to be, then everyone must concede that the decision conformed with well-established law.

Counsel for the petitioner realize, of course, that they cannot secure a writ of certiorari by coming into this Court with the straightforward contention that the Seventh Circuit Court of Appeals decided this case under an alleged misconception of the facts.

On the other hand, they cannot find in the very full opinion of the Seventh Circuit Court of Appeals, any expression or any statement or any exposition of the law which can even be claimed to be at variance with the law as determined by this Court and as applied by all of the circuit courts of appeal.

Counsel for the petitioner find it necessary, therefore, to adopt an expedient. It is an old and often tried expedient. Counsel have recourse to the phrase, "*in effect*." The Circuit Court of Appeals is said to have held "*in effect*" that the law is black, whereas in truth the law is white. "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the inventor of a presumably * * *" (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that one who has presumably invented * * *" (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee may use the patent * * *" (Petitioner's Brief, p. 6). "The Court of

Appeals for the Seventh Circuit erred in holding, in effect, that the owner of the patent can extend the monopoly * * * (Petitioner's Brief, p. 6). "The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee, by improving one element * * * (Petitioner's Brief, p. 7). Etc., etc.

"In effect"!

If the facts are as the Court has found them to be, then its decision recognizes and applies the white law just as it really is. If, on the other hand, the facts are what the petitioner claims them to be, then the decision of the Court must necessarily mean that it thinks the law is black.

"The Seventh Circuit Court of Appeals held, *in effect*, that the law is black"—such is the gravaman of the petition.

The petitioner's real complaint is not that the Court misunderstood or misstated the law, but rather that the Court did not find the facts to be what the petitioner asserted them to be.

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THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA HELD THE BUTLER PATENT IN SUIT TO BE INVALID. AN APPEAL IS PENDING. IT REMAINS TO BE SEEN WHETHER THE THIRD CIRCUIT COURT OF APPEALS WILL AGREE WITH OR DISAGREE WITH THE SEVENTH CIRCUIT COURT OF APPEALS.

Counsel for the petitioner devote seventy-three pages of their petition and brief to the development of the "conclusion" (Petitioner's Brief, p. 48) that the decision and judgment of the Circuit Court of Appeals for the Seventh Circuit involves six so-called "direct conflicts"—all separate and distinct from one another.

These six alleged "conflicts" include one real conflict. This one real conflict is a conflict between the decision of the District Court for the Western District of Pennsyl-

vania on the one hand, and the decision of the Circuit Court of Appeals for the Seventh Circuit on the other hand.

In the instant suit, Judge Lindley, sitting in the District Court for the Northern District of Illinois, held claim 2 of Butler patent No. 1,593,791, to be valid and to have been contributorily infringed by the Lincoln Company's sale of one of the connector parts of the new combination claimed in the Butler patent.

The Seventh Circuit Court of Appeals affirmed Judge Lindley's decree.

In the District Court for the Western District of Pennsylvania, in a suit alleging identically similar acts to constitute a contributory infringement, Judge Schoonmaker held this same claim 2 of the Butler patent to be invalid. In that suit, the plaintiff, Stewart-Warner Corporation, has taken an appeal to the Court of Appeals for the Third Circuit. But the Third Circuit Court of Appeals has not yet even heard this appeal,—nor of course rendered any decision.

It remains to be seen, therefore, whether the Third Circuit Court of Appeals will agree with or disagree with the Seventh Circuit Court of Appeals.

COUNSEL FOR PETITIONER REALIZE THAT A CONFLICT OF DECISION BETWEEN THE SEVENTH CIRCUIT COURT OF APPEALS AND THE DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA IN A CASE NOW ON APPEAL TO THE THIRD CIRCUIT COURT OF APPEALS AND AS YET UNHEARD AND UNDECIDED, WOULD PROBABLY NOT RESULT IN THE GRANT OF A WRIT OF CERTIORARI.

Counsel for the petitioner are of course sufficiently familiar with the rules and policies of this Court to realize that a conflict of decision between the Seventh Circuit Court of Appeals on the one hand, and the District Court for the Western District of Pennsylvania on the other

hand, would probably not result in the grant of a writ of certiorari to the Seventh Circuit Court of Appeals. Counsel have found it expedient, therefore, to present five other contentions, all, however, under the appellation of "direct conflict."

This one real conflict, *i. e.*, the conflict of decision between the Court of Appeals for the Seventh Circuit on the one hand, and the District Court for the Western District of Pennsylvania on the other hand, is thrown into the petitioner's petition for a writ of certiorari as an element of defensive coloration. It is not—and could not well be—one of the formal "reasons relied upon for allowing the writ of certiorari," as set forth in the petition for a writ of certiorari.

**ALL OF THE QUESTIONS RAISED BY THE PETITION INVOLVE
PURE QUESTIONS OF FACT.**

Although counsel for petitioner have attempted to capture and engage the interest of this Court by contorting their contentions into asserted conflicts of decision upon pure questions of law, it will be found that the petitioner's contentions resolve themselves into the complaint that the facts are not what the Seventh Circuit Court of Appeals found and held them to be.

**AS BETWEEN THE SEVENTH CIRCUIT COURT OF APPEALS AND
THE EIGHTH CIRCUIT COURT OF APPEALS, THERE IS NO
CONFLICT OF DECISION ON THE SAME MATTER.**

In the instant suit against the Lincoln Engineering Company, the Seventh Circuit Court of Appeals found the Butler patent to be valid.

In the suit against the Jiffy Company, the Eighth Circuit Court of Appeals also found the Butler patent to be valid, saying, at 81 Fed. (2d) 786, 791:

"We think that when we allow to the Butler patent

such presumption of validity as its issue by the Patent Office would entitle it to " * * " that the defense of anticipation for want of novelty was not sustained."

In the instant suit against the Lincoln Company, the Seventh Circuit Court of Appeals decided that the defendant's sale of a shouldered or headed nipple like that illustrated in the accompanying Fig. 1 (R. p. 397) involved a

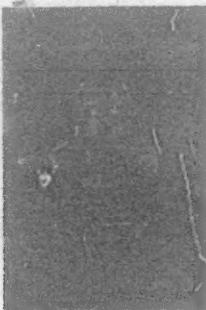


FIG. 1.

This cut illustrates the shouldered and headed nipple, the sale of which by the Lincoln Engineering Company was held by the Seventh Circuit Court of Appeals to involve a contributory infringement of claim 2 of the Butler patent.

contributory infringement of claim 2 of the Butler patent. This was for the reason that the defendant manufactured and sold this element of claim 2 with the knowledge and intent that it would be used as a part of the complete combination of claim 2 as illustrated in the accompanying Fig. 2 (R. p. 319).

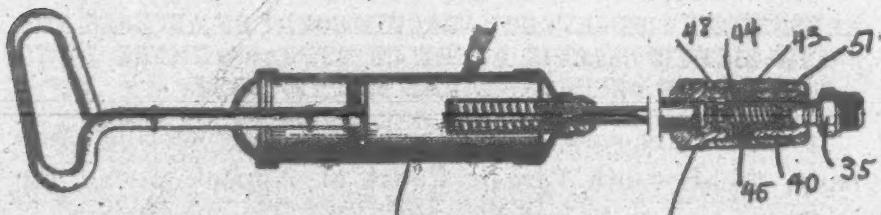


FIG. 2.

This cut illustrates the complete lubricating equipment held by the Seventh Circuit Court of Appeals to embody the invention of claim 2 of the Butler patent, and of which the Lincoln Company's shouldered and headed nipple constituted a part.

In the suit against the Jiffy Company, the Eighth Circuit Court of Appeals held that the Jiffy Company's sale of a compressor having coupler mechanism of the kind illustrated in the accompanying Fig. 3 (R. p. 363 of the record

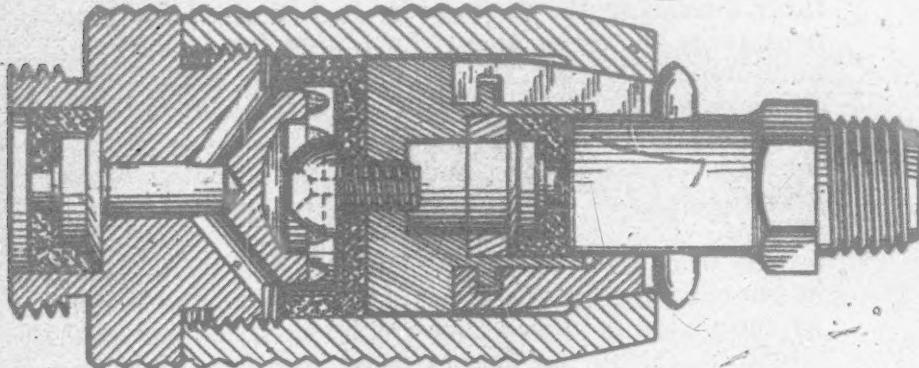


FIG. 3.

This cut illustrates the connector parts of the lubricating apparatus which was held by the Eighth Circuit Court of Appeals not to infringe claim 1 of the Butler patent.

in *Stewart Warner v. Jiffy*, No. 114, October Term, 1936), did not involve an infringement of a different claim of the Butler patent, namely, claim 1.

THE JIFFY COMPANY'S COMBINATION DID NOT COMPRIZE A NIPPLE HAVING A HEAD OR A THROAT OR A SHOULDER, NOR DID IT HAVE LOCKING ELEMENTS OR JAWS ADAPTED FOR COOPERATION WITH SUCH A HEADED NIPPLE, AND WAS HELD, THEREFORE, BY THE EIGHTH CIRCUIT COURT OF APPEALS, NOT TO INFRINGE CLAIM 1 OF THE BUTLER PATENT.

In reaching its conclusion that the device sold by the Jiffy Company did not infringe claim 1 of the Butler patent, the Eighth Circuit Court of Appeals restricted claim 1 to a construction which involved the latching of the locking elements to the throat of a nipple having a head and a shoulder and a throat. It held that the Jiffy Company's device did not involve this construction and that it did not, therefore, infringe claim 1 of the Butler patent. These distinc-

tions which thus avoided infringement of claim 1 of the Butler patent were stated by the Eighth Circuit Court of Appeals as follows:

"But when we turn to the Butler patent specifications disclosing the 'means' he had in mind for 'compressively engaging about the nipple for locking said parts together,' we find no reference to any elements corresponding to such positive wedging means as above described. He describes a nipple *having a head, a throat, and a shoulder*, and segments adapted to slip over the head of such a nipple and embrace the throat thereof. Then he specifies spring fingers mounted on the forward face of the piston. Ample room is left in the cylinder for the free play of the spring fingers. As the piston is moved forward by the pressure of the lubricant, the spring fingers do engage and press upon the segments so that the segments are pressed upon the throat of the nipple. But the nipple is not specified to be held against longitudinal displacement by the force of the gripping. The language of the specifications is that the segments are held in position on the throat by the spring fingers, *but it is the 'shoulder' on the nipple which 'prevents the retraction of the segments' or pulling away from the nipple.* We conclude from consideration of all the specifications and the drawing that the inventor excluded disclosure of elements which would be actuated by the forward movement of the piston to lock the coupler to the nipple by any unyielding action, but that he disclosed only such a yielding compression as would be accomplished by spring fingers." (81 Fed. (2d) 786, 792-3.) (Italics ours.)

The Jiffy Company's combination, as is illustrated in the accompanying Fig. 3, did not comprise a nipple having a head or a throat or a shoulder, nor did it have locking elements or jaws adapted for cooperation with such a headed nipple. It did not, therefore, in the opinion of the Eighth Circuit Court of Appeals as expressed in the foregoing excerpt, involve any infringement of claim 1 of the Butler patent. This was for the reason that claim 1

of the Butler patent must be interpreted and limited in the light of the specifications and drawings to include these features,—features which the Jiffy Company's construction did not embody.

IN THE LINCOLN CASE, THE DEFENDANT'S NIPPLE WAS PROVIDED WITH "A HEAD, A THROAT, AND A SHOULDER, AND SEGMENTS ADAPTED TO SLIP OVER THE HEAD OF SUCH A NIPPLE AND EMBRACE THE THROAT THEREOF," i. e., THE VERY THINGS WHICH THE EIGHTH CIRCUIT COURT OF APPEALS EXPRESSLY HELD TO BE LACKING IN THE NIPPLE OF THE JIFFY COMPANY'S COMBINATION.

In the suit against the Lincoln Company, decided by the Seventh Circuit Court of Appeals, the defendant's nipple did have "a head, a throat, and a shoulder, and segments adapted to slip over the head of such a nipple and embrace the throat thereof," i. e., the very things which the Eighth Circuit Court of Appeals expressly held to be lacking in the nipple of the combination for which the Jiffy Company's device was sold. Certainly, the decision of the Seventh Circuit Court of Appeals that the Lincoln Company infringed by selling a thing having all of these features, was not in conflict with the decision of the Eighth Circuit Court of Appeals that no infringement was involved in the Jiffy Company's sale of a device having none of these features.

IT IS ONLY WHEN THE VALIDITY OF THE PATENT IN SUIT IS IN DOUBT UPON THE SCORE OF INVENTION THAT PROOFS OF COMMERCIAL SUCCESS ARE ADMISSIBLE TO RESOLVE THE DOUBT IN FAVOR OF VALIDITY.

In the suit against the Jiffy Company, the defendant contended that the Butler patent was invalid. In answer to this contention and in support of the validity of the patent, the plaintiff undertook to show that it had sold a great quantity of lubricating equipment embodying the inven-

tion described in claim 1 of the Butler patent. The reason was, of course, that in case of doubt as to the validity of a patent claim, that doubt may be resolved in favor of the validity of the patent by proof of notable commercial success in the manufacture and sale of the device of the patent. Such proofs were not admissible for any other purpose.

As was said by this Court in its opinion in the recent case of *Paramount v. American Tri-Ergon*, 294 U. S. 463, 79 L. Ed. 997, 1003 (March 4, 1935—Opinion by Mr. Justice Stone):

“Respondents also allege that the positive film produced by its method is more useful than any it had been possible to produce by other methods, and that it has found all but universal acceptance. These considerations, it is urged, should turn the scale in favor of invention.

“Laying aside the objection that *it is only when invention is in doubt that advance in the art may be thrown in the scale*, *DeForest Radio Co. v. General Electric Co.*, 283 U. S. 664, 685, 75 L. ed. 1339, 1348, 51 S. Ct. 563; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 495, 496, 23 L. ed. 952, 954, 955, we think the evidence of utility and prompt acceptance of the patented method, in the circumstances of this case, adds little weight to the claim of invention.” (Emphasis ours.)

THE EIGHTH CIRCUIT COURT OF APPEALS HELD CLAIM 1 OF THE BUTLER PATENT TO BE VALID DESPITE THE FACT THAT PLAINTIFF HAD NOT MADE OR SOLD ANY LUBRICATING EQUIPMENT IN CONFORMITY WITH THE DETAILS SHOWN AND DESCRIBED IN THE DRAWINGS AND SPECIFICATIONS OF THE BUTLER PATENT.

The Eighth Circuit Court of Appeals did not hold that the Alemite Hydraulic lubricating equipment sold by the plaintiff, Stewart-Warner Corporation, did not realize or embody the invention set forth in the claims of the Butler

patent. What the Eighth Circuit Court of Appeals did say in this connection was that

"The plaintiff has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent * * *." (81 Fed. (2d) 786, 788)

The Eighth Circuit Court of Appeals held claim 1 of the Butler patent to be valid, despite the fact that the plaintiff had not "made or sold any coupler constructed according to the above drawing and specifications of its Butler patent."

This all means merely that the Eighth C. C. A.'s holding of validity with respect to claim 1, was not due to the plaintiff's alleged commercial success of the invention disclosed in Butler's drawings and specifications. It was due to conclusions reached upon other grounds.

THE QUESTION WHETHER OR NOT THE PLAINTIFF'S COMMERCIAL EQUIPMENT EMBODIED EITHER OF THE CLAIMS OF THE BUTLER PATENT WAS NOT AT ISSUE AT ALL IN THE SUIT AGAINST THE JIFFY COMPANY.

There was, of course, therefore, no decision upon the question whether the plaintiff's Alemite Hydraulic equipment embodied the combination of elements set forth in claim 1 (much less the combination of elements set forth in claim 2, which alone was involved in the Lincoln case and which was not involved at all in the Jiffy case). Indeed, the question whether or not the plaintiff's Alemite Hydraulic equipment embodied either of the claims of the Butler patent, was not at issue at all in the suit against the Jiffy Company. The only questions at issue were

- (a) the validity of claim 1; and
- (b) the defendant's infringement of claim 1. The issue of validity was decided in favor of the plaintiff. The issue of infringement was decided in favor of the defendant.

This involved simply and solely the determination that the defendant Jiffy Company's device did not embody the combination of elements set forth in claim 1.

In so far as the plaintiff's proofs of its sales of the Ale-mite Hydraulic equipment were concerned, the holding of validity by the Eighth Circuit Court of Appeals was in conformity with the plaintiff's contentions (although upon grounds other than that of the plaintiff's commercial success).

THE EIGHTH CIRCUIT COURT OF APPEALS HELD THAT ONE CERTAIN DEVICE DID NOT INFRINGE CLAIM 1. THE SEVENTH CIRCUIT COURT OF APPEALS HELD THAT AN ENTIRELY DIFFERENT DEVICE DID INFRINGE CLAIM 2. NO MATTER WHAT THE DECISIONS OF THE TWO COURTS MIGHT HAVE BEEN, THEIR CONCLUSIONS IN RESPECT OF THIS MATTER OF INFRINGEMENT MUST NECESSARILY HAVE BEEN "DIFFERENT CONCLUSIONS."

It is true, of course, that the Seventh Circuit Court of Appeals reached what might very appropriately be called a "different conclusion" from that reached by the Eighth Circuit Court of Appeals. This was necessarily so, because the issues of infringement were entirely different in the two suits. The Eighth Circuit Court of Appeals held that one certain device did not infringe claim 1. The Seventh Circuit Court of Appeals held that an entirely different device did infringe claim 2. No matter what the decisions of the two courts may have been, their conclusions in respect of this matter of infringement must necessarily have been different. The Seventh Circuit Court of Appeals held that the Lincoln Company's sale of a nipple having "a head, a throat, and a shoulder," did involve infringement of claim 2. If the Eighth Circuit Court of Appeals had held that the Jiffy Company's sale of its compressor and coupler mechanism did involve infringe-

ment of claim 1, the two courts would unavoidably have reached different conclusions. This was inevitable, simply because of the difference in the questions to be decided.

When, therefore, the two courts had before them two different claims, and had before them two entirely different issues of infringement, it can doubtless be said that the two courts reached "different conclusions." It cannot be truthfully said, however, that such different conclusions relative to such different matters involved a decision by one Circuit Court of Appeals "in conflict with the decision of another circuit court of appeals on the same matter."

It must have been evident to counsel for the petitioner that they could not spell out of the real facts of the decision of the Eighth C. C. A. in the Jiffy case, and of the decision of the Seventh C. C. A. in the instant suit against the Lincoln Company, any real or substantial conflict of decision between the two courts. Counsel for the petitioner were apparently familiar with such decisions of this court as that in *Lane & Bowler Corp. v. Western Well Works*, 261 U. S. 387, where, at page 393, this court said:

"* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

The first sentence of that same opinion is,

"This is an ordinary patent case."

SINCE THERE IS NO REAL CONFLICT BETWEEN THE DECISIONS OF THE SEVENTH CIRCUIT COURT OF APPEALS AND THE EIGHTH CIRCUIT COURT OF APPEALS ON THE SAME MATTER, COUNSEL FOR PETITIONER HAVE FOUND IT EXPEDIENT TO PRESENT A DISINGENUOUS STATEMENT AND ARGUMENT.

In the hope, therefore, of capturing the attention and interest of this Court, counsel for the petitioner have found it expedient to present a rather disingenuous statement and argument relative to the allegation of conflict between the decisions of the Seventh and Eighth circuit courts of appeal.

On page 788 of Volume 81 of the Federal Reporter, Second Series, the Eighth Circuit Court of Appeals said that

"The plaintiff has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent * * *."

Again on page 789 of its opinion, the Court referred to the fact that

"The plaintiff had not manufactured for sale any couplers according to the drawing or specifications on which the claim in suit reads."

In so far as the language or any possible interpretation of the claim is concerned, no one has ever suggested that the claim did not read upon the structure shown in the drawing and described in the specification of the Butler patent. The Eighth C. C. A. here referred quite incidentally to this fact. No one has ever questioned the correctness of this incidental statement.

THE SEVENTH CIRCUIT COURT OF APPEALS IS IN COMPLETE ACCORD WITH THE EIGHTH CIRCUIT COURT OF APPEALS THAT THE PLAINTIFF-RESPONDENT'S COMMERCIAL EQUIPMENT DOES NOT CORRESPOND WITH THE DETAILS OF ANY OF THE DRAWINGS AND SPECIFICATIONS OF THE BUTLER PATENT.

The opinion of the Seventh Circuit Court of Appeals is, however, in complete accord with that of the Eighth Circuit Court of Appeals, to the effect that the plaintiff-respondent's commercial equipment was not made in accordance with the drawings and specifications of the Butler patent. The two courts were in complete agreement upon this matter. Judge Evans' opinion for the Seventh Circuit Court of Appeals states this agreement with the Eighth Circuit Court of Appeals, saying in this connection, however, that

"The question is not whether Fig. 2 of the drawings fully represents the concept of the inventor. Figures which accompany the patents are often presented merely to elucidate the thought expressed in the specifications. Their study is decidedly helpful in most cases, but it can hardly be expected that all of the possible variations in structure will be set forth in specifications or drawings. Frequently the improved type is described in detail. True, there are instances where specificity is necessary in order to distinguish the invention from the prior art. More frequently however, it is the principle of operation which is being illustrated rather than an effort to confine the invention to the exact figures shown in drawings.

"Our conclusion is that such departures from the Butler patent as were made in the commercial structures were nevertheless the equivalent of the Butler claim, and they embodied the mechanical principles which were described in the Butler patent." (91 Fed. (2d) 757, 766.)

The Eighth Circuit Court of Appeals did not say anything which was in any wise inconsistent with these views as thus expressed by the Seventh Circuit Court of Appeals.

SOME EXAMPLES OF THE PETITIONER'S MANY TIMES REITERATED MISREPRESENTATION THAT THE PLAINTIFF-RESPONDENT'S ALEMITE HYDRAULIC EQUIPMENT INVOLVED A QUESTION IN ISSUE AND WAS HELD BY THE EIGHTH CIRCUIT COURT OF APPEALS NOT TO EMBODY THE INVENTION COVERED BY CLAIM 1 OF THE BUTLER PATENT.

Counsel for the petitioner have endeavored to contort the language in which the two courts of appeal have stated their agreement that the plaintiff-respondent's commercial equipment does not correspond with the details of the drawings and specifications of the Butler patent, into a statement—many times repeated—that the Eighth Circuit Court of Appeals held that the plaintiff-respondent's Alemite Hydraulic equipment did not embody the invention set forth in claim 1 of the Butler patent.

Thus, on page 12, counsel for the petitioner say that the Eighth C. C. A.

"held that neither the accused Jiffy coupler nor indeed plaintiff's own commercial 'Alemite Hydraulic' coupler responded to the coupler part of the Butler claim-language for the above outlined reason."

Thus again, on page 15 of their brief, counsel for the petitioner refer to

"plaintiff-respondent's commercial form of coupler (the so-called 'Alemite Hydraulic' coupler) which the Court of Appeals for the Eighth Circuit in the Jiffy case held not to be the coupler of the Butler patent and to be outside the scope thereof."

The scope of the Butler patent is of course to be measured by its claims. There was no issue as to whether either claim described the plaintiff's "Alemite Hydraulic" equipment, and unavoidably, therefore, no decision upon that issue.

Again on page 16 of their brief, counsel for the petitioner say that

"The Court of Appeals for the Eighth Circuit . . ."

also clearly and expressly and necessarily excluded plaintiff-respondent's 'Alemite Hydraulic' coupler from the scope of the Butler patent."

Again on page 18 of their brief, counsel for the petitioner say that

"Plaintiff-respondent's own commercial 'Alemite Hydraulic' coupler is not in fact the coupler defined in the coupler part of the Butler claim-language, for the reason relied upon by the Court of Appeals for the Eighth Circuit."

Still again, on the chart opposite page 19 of their brief, counsel for the petitioner present a picture of certain parts of the plaintiff's "Alemite Hydraulic" equipment, and apply a caption reading,

"Respondent's own coupler ('Alemite Hydraulic') held outside the scope of coupler part of Butler claim-language."

This picture and this subcaption are placed beneath a main caption reading,

"The devices before the Circuit Court of Appeals for the Eighth Circuit in Respondent's suit against Jiffy Lubricator Co., 81 Fed. 2d 786 (certiorari denied 299 U. S. 554)."

Even in connection with their argument of wholly separate and distinct points, counsel for the petitioner repeat and reiterate their misrepresentation of the issues and of the decision of those issues by the Eighth Circuit Court of Appeals in the Jiffy case. Thus, for example, on page 31 of their brief, counsel for the petitioner say that

"The Court of Appeals for the 8th Circuit * * * held that plaintiff-respondent's own allegedly Butler-improved couplers * * * were not within the scope of the claim thereof."

This repeatedly reiterated misstatement cannot convert the agreement of the two courts upon the fact that the plaintiff-respondent's commercial equipment differed in

detail from the structures illustrated in the drawings and described in the specifications, into a conflict upon a question which was not even in issue in the Jiffy case, namely, the question whether the plaintiff-respondent's Alemite Hydraulic lubricating equipment comes within the scope of one or another of the claims of the Butler patent.

**EVEN THE TYPOGRAPHY OF THE PETITIONER'S BRIEF IS
AVAILLED OF BY COUNSEL FOR PETITIONER TO AID IN THE
SUSTAINED DISINGENUOUSNESS OF THEIR PRESENTATION.**

The disingenuousness with which counsel for petitioner present the matter, is illustrated by another stratagem employed by them. In accordance with almost universal custom, the brief of counsel for the petitioner employs the convenient format of indenting the margins of extended quotations. This aid to clarity is first employed on page 3 of the petitioner's brief, in connection with the quotation of certain statutes, and is then uniformly followed throughout the brief.

On page 12 of their brief, they similarly indent some twelve lines of printed matter. But in this lone instance this matter is not quoted from anything at all. It is the original language of counsel for the petitioner. Yet the device of this indented margin is employed in a context and in such a manner as almost inevitably to convey the impression that the language of counsel for the petitioner is that of the Circuit Court of Appeals for the Eighth Circuit. The paragraph of petitioner's counsel runs as follows:

"In the Jiffy case, the Circuit Court of Appeals for the Eighth Circuit held that plaintiff-respondent's 'Alemite Hydraulic' coupler is not the coupler defined by the coupler part of the Butler claim-language for the reason that:"

Then follows the indentation in which the Circuit Court of Appeals appears to say:

"the coupler part of the claim-language requires that the nipple-engaging means (the three radially-movable locking jaws 40) be compressively actuated. The only means of 'compression' disclosed, are Butler's resilient spring fingers 42, which do subject the radially-movable locking jaws 40 to spring-compression. Plaintiff-respondent's commercial 'Alemite Hydraulic' couplers do not have any such spring fingers nor any other resilient or spring-like or 'compressive' jaw-actuating means. Instead, the jaws of the 'Alemite Hydraulic' coupler are actuated by an unyielding cam or wedge surface."

Although the typography uniformly employed throughout the brief of counsel for the petitioner, coupled with the introductory colon and the context, would lead one inevitably to regard this passage as a quotation from the opinion of the Eighth Circuit Court of Appeals, the fact of the matter is that the indented language is solely and originally that of counsel for the petitioner.

This sort of disingenuousness would doubtless not be worthy of such extended comment, except for the fact that the same disingenuousness permeates the entire petition and the entire brief in support of it.

THE REAL TEST OF CONFLICT OR LACK OF CONFLICT IN THE DECISIONS OF THE TWO COURTS OF APPEAL IS TO BE FOUND IN A COMPARISON OF THE DECREES OF THE TWO COURTS.

The decree of the Eighth Circuit Court of Appeals in the Jiffy case was that

"the defendant, Jiffy Lubricator Company, has not infringed claim 1 of said Butler Patent No. 1,593,791, by the manufacture and sale of lubricating apparatus exemplified by Plaintiff's Exhibits 10, 11, 12, 13 and 14, and Defendant's Exhibit A, and as illustrated in the drawings Plaintiff's Exhibits 20, 21, 22, 23 and 24."

The decree affirmed by the Seventh Circuit Court of Appeals in the Lincoln case was

"That the defendant Lincoln Engineering Co. of Illinois has contributorily infringed claim 2 of said Butler patent No. 1,593,791, by the sale of 'Lincoln-Kleenseal' nipples or fittings of the types illustrated in Bulletin 111 of the Lincoln Engineering Co. of Missouri, Defendants' Exhibit A-53 herein, and exemplified in Plaintiff's Exhibits 27a and 27b herein, * * * * * (R. 441.)

and that defendant be permanently enjoined

"from using, or making or selling for use within the United States lubricating-receiving nipples or fittings of the kind illustrated in Bulletin 111 of the Lincoln Engineering Co. of Missouri, and exemplified by Defendants' Exhibit A-53 and by Plaintiff's Exhibits 27a and 27b herein, * * * * * (R. 442.)

These two decrees did not even relate to "the same matter." (Rule 38, Sec. 5 (b).)

THE LINCOLN COMPANY COULD MAKE, USE, AND SELL DEVICES IDENTICAL WITH THOSE MADE AND SOLD BY THE JIFFY COMPANY AND IN ISSUE BEFORE THE EIGHTH C. C. A. WITHOUT VIOLATING THE DECREE OR THE INJUNCTION OF THE SEVENTH C. C. A.

The whole subject is put at rest by the simple fact that the Lincoln Engineering Company could make, use, and sell devices identical with those made and sold by the Jiffy Company and in issue before the Eighth Circuit Court of Appeals without violating the decree or the injunction in the Lincoln case. Any attempt on the part of the plaintiff to restrain the Lincoln Company from manufacturing and selling the Jiffy Company's type of equipment would necessarily involve the commencement of a new suit directed against this new and different matter. Such a new suit would necessarily have to be brought under a different claim of the Butler patent, i. e., claim 1 rather than claim 2. In such a new suit, the plaintiff could not even claim a *res judicata* against the Lincoln Company.

IN SUMMARY, THEN, RELATIVE TO THE PETITIONER'S
"POINT I".

The questions in issue before the Eighth Circuit Court of Appeals involved claim 1 only.

The questions in issue before the Seventh Circuit Court of Appeals involved claim 2 only.

In the Eighth C. C. A. the issue of infringement had to do solely with the Jiffy Company's combination of its coupler and compressor with a straight-sided cylindrical fitting. In the Seventh C. C. A. the issue of infringement had to do solely with the Lincoln Company's nipple having a head, a throat, and a shoulder.

These very features were enumerated by the Eighth Circuit Court of Appeals in distinguishing the disclosure of the Butler patent from the lubricating equipment manufactured and sold by the Jiffy Company. These very features were incorporated in the Lincoln Company's device.

The Eighth Circuit Court of Appeals held that the Jiffy Company's product did not infringe claim 1. The Seventh Circuit Court of Appeals held that the Lincoln Company's product did infringe claim 2.

Both courts agreed in holding that the Butler patent was valid.

Both courts agreed that the plaintiff's Alemite Hydraulic equipment was not made in accordance with the details of any of the figures shown in any of Butler's drawings or described in any of Butler's specifications.

The Seventh Circuit Court of Appeals had before it the issue whether the plaintiff-respondent's Alemite Hydraulic equipment came within the scope of claim 2 of the Butler patent. It held that it did. There was no such issue before the Eighth Circuit Court of Appeals, either as to claim 1 or as to claim 2 and the Eighth Circuit Court of Appeals did

not pass nor attempt to pass upon that issue relative to either of these claims.

The lack of any conflict between the decision of the Seventh C. C. A. and that of the Eighth C. C. A. is demonstrated by the fact that the Lincoln Company could make, use, and sell devices identical with those made and sold by the Jiffy Company without violating the decree or injunction in the Lincoln suit.

RELATIVE TO PETITIONER'S "POINT II": THE MISNOMERS EMPLOYED BY COUNSEL FOR THE PETITIONER DO NOT DESCRIBE EITHER THE CASE WHICH WAS PRESENTED BY THE PLAINTIFF-RESPONDENT OR THE CASE WHICH WAS DECIDED BY THE SEVENTH CIRCUIT COURT OF APPEALS.

The petitioner's very statement and argument of its Point II begs the question which was decided by the Seventh Circuit Court of Appeals, and which the petitioner seeks to have reviewed by this Court.

Over and over and over again, counsel for the petitioner refer to the nipple element of the Butler combination as an old nipple, or an old fitting, or an old-style grease cup, etc., etc. The alleged oldness of this element is reiterated contrasted with what counsel choose to call "an improved hose coupler," "a novel combination of coupler composing elements," the "improved chuck type hose coupler," etc., etc.

The allegedly old grease cup or nipple or fitting is referred to as being "admittedly" old. What counsel refer to as the improved coupler is generally referred to as the "assertedly" novel or improved hose coupler.

All of these adjectives and misnomers are insinuatingly employed as though they represented the contentions of the plaintiff-respondent, and as though they represented the conclusions reached by the Seventh Circuit Court of

Appeals. These misnomers do not describe either the case which was presented by the plaintiff-respondent or the case which was decided by the Seventh Circuit Court of Appeals.

THE OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS REFERS TO AND DISCUSSES THE DECISION OF THIS COURT IN ROGERS VS. ALEMITE, AND EXPRESSLY RECOGNIZES IT AS STATING THE LAW WHICH IS TO BE OBSERVED, RESPECTED, AND APPLIED BY THE LOWER COURTS.

The decision of this Court in the cases of *Rogers v. Alemite*, and *Bassick v. Hollingshead*, 298 U. S. 415, was of course pressed upon the attention of the Seventh Circuit Court of Appeals and upon the District Court in which the case was originally decided. The opinions of the District Court and the opinion of the Court of Appeals all refer to it. They all discuss it. They all distinguish the facts of the instant case from the facts of the cases of *Rogers v. Alemite* and *Bassick v. Hollingshead*. All of these decisions of the lower courts expressly recognize the decision of this court as stating law which must be observed, respected, and applied by the lower courts. Thus, for example, Judge Evans, in writing his opinion for the Seventh Circuit Court of Appeals, said:

"The uppermost question in this case is the controlling effect of the *Bassick v. Hollingshead* opinion, *supra*. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language." (91 F. (2d) 757, 761.)

In this same opinion, his Honor Judge Evans said further, relative to the opinion of this Court in the Rogers and Hollingshead cases:

"While going no further than is necessary to defeat

the patent in the present case, the conclusion from appellant's brief is unavoidable, that *Bassick v. Hollingshead, supra*, revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court (in Pennsylvania) in *Stewart-Warner v. Universal Co.*, 15 F. Supp. 410." (91 F. (2d) 757, 760.)

Judge Evans went so far as to say:

"While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling." (91 F. (2d) 757, 761.)

It would be impossible to acknowledge more clearly than the Seventh Circuit Court of Appeals has done, the authority of this Court's decision in the Rogers and Hollingshead cases.

In its opinion, the Seventh Circuit Court of Appeals said explicitly, in just so many words,

"We accept, of course, without question, this opinion as applied to the facts in the case that was before the Supreme Court." (91 Fed. (2d) 757, 762.)

THE SEVENTH CIRCUIT COURT OF APPEALS EMPHASIZED BY THE USE OF ITALICS THAT PART OF YOUR HONORS' DECISION IN THE ROGERS AND HOLLINGSHEAD CASES WHICH DISTINGUISHES, RECONCILES, AND HARMONIZES IT WITH THE AGE-OLD LAW WHICH HAS BEEN OBSERVED AND APPLIED BY ALL OF THE FEDERAL COURTS.

The opinion of the Seventh Circuit Court of Appeals not only refers to but quotes extensively from the opinion of this Court in the Rogers and Hollingshead cases. In so doing, the Court of Appeals emphasized by the use of italics, the sentence which reconciles and harmonizes your Honors' opinion in the Rogers and Hollingshead cases with

the age-old law which has been observed and applied by this Court and by all of the federal courts throughout the United States. This quotation as italicized and thus emphasized by the Seventh Circuit Court of Appeals is as follows:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler and grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, re-patent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts." (91 F. (2d) 757, 761.)

In the Rogers and Hollingshead cases, your Honors found and held that the patentee, Gullborg, had "*improved one element of an old combination whose construction and operation is otherwise unchanged.*"

It was these characteristics which distinguished the disclosure of the Gullborg patent from the disclosures of the many, many other patents in which the furnishing of one element with knowledge and intent that it was to be incorporated into the combination claimed in the patent in suit, had been held by this Court and by all of the federal courts to constitute an act of contributory infringement.

THE SEVENTH CIRCUIT COURT OF APPEALS DETERMINED AS A MATTER OF FACT THAT BUTLER BROUGHT TOGETHER A NEW COMBINATION OF OLD ELEMENTS IN SUCH A WAY AS TO INVOLVE A NEW CONSTRUCTION, A NEW MODE OF OPERATION, AND A NEW AND UNITARY RESULT, AND THAT HE DID NOT MERELY "IMPROVE ONE ELEMENT OF AN OLD COMBINATION WHOSE CONSTRUCTION AND OPERATION IS OTHERWISE UNCHANGED."

Everybody concedes that Butler brought together for the first time the seven elements enumerated and described in claim 2 of the Butler patent. Everybody concedes that "Butler was the first to devise a lubricating system in which the sealing of the joint between the end of the nipple and coupler and the mechanical grip were effected automatically by the pressure of the lubricant, which pressure was produced by the normal pumping operation of the compressor." Such was the finding of fact by the District Court as adopted by the Court of Appeals and as quoted by it in its opinion.

In the instant suit against the Lincoln Engineering Company, the District Court, and later the Court of Appeals made it their task to determine as a matter of fact whether Butler, like Gullborg, had merely "improved one element of an old combination whose construction and operation is otherwise unchanged," or whether Butler, like Berliner (the patentee in *Leeds & Catlin v. Victor*, 213 U. S. 301 and 325), had brought together a new combination of old elements in such a way as to involve a new construction, a new mode of operation, and a new and unitary result.

Judge Lindley in the District Court, and Judge Evans and Judge Sparks and Judge Major in the Seventh Circuit Court of Appeals, made independent determinations of this factual question. All came to the conclusion that as a matter of fact Butler had not merely improved one element of an old combination whose construction and opera-

tion is otherwise unchanged, but that he had brought together a new combination of seven elements, each generically old but each and every one so related to and affected by the presence and coaction of all of the others as to produce the new and unitary result which the courts have ascribed to Mr. Butler and which not even the petitioner attempts to detract from him.

AS AGAINST THE PETITIONER'S PRETENDED STATEMENT OF THE FACTS, WE CONTRAST THE REAL FACTS AS DETERMINED BY THE SEVENTH CIRCUIT COURT OF APPEALS,— AND SOLELY IN THE LANGUAGE EMPLOYED AND ADOPTED BY THAT COURT.

Counsel for the petitioner have pretended to state the facts in their own language. Let us state the facts in the language employed in the decisions of the Courts. It will promptly become apparent that the facts as determined by the courts are radically at variance with the facts as presented to your Honors by counsel for the petitioner.

In its opinion, the Seventh Circuit Court of Appeals pointed out that

"The District Court prepared his own findings and conclusions which fully covered the nature of the invention, the claims, the defenses, the state of the art, as well as other material issues." (91 Fed. (2d) 757, 758.)

At page 759 of its opinion, the Court of Appeals adopted Judge Lindley's characterization of the Butler invention, saying:

"Judge Lindley, describing the patent, said:
" * * * Butler was the first to propose or to devise a lubricating system in which the sealing of the joint between the end of the nipple and the coupler and the mechanical grip between the nipple and the coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, * * * the advantage of this

combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized. . . . due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure."

A little later in the opinion of the Seventh Circuit Court of Appeals, his Honor Judge Evans quoted *in extenso* what he called "the substance of the more important findings of the trial court."

The Court of Appeals approved and adopted Judge Lindley's factual determinations. The Judges of the Court of Appeals pointed out, however, that they had not done so either blindly or carelessly. They said expressly,

"It is only after observation of the various lubricating systems that we have come to the same conclusion as was reached by the District Court." (91 Fed. (2d) 757, 765.)

Before quoting further from the opinion of the Court of Appeals relative to the facts which distinguish the instant suit, let us turn first to the factual situation as found by the District Court and subsequently approved and adopted by the Court of Appeals. The defendant's various petitions subsequent to the filing of an original opinion by the District Court, led Judge Lindley to supplement his original opinion with two further opinions. Counsel for the

petitioner have been careful to omit these subsequent proceedings and opinions from the record presented by them in this Court. Judge Lindley's first opinion is reported at 15 Fed. Supp. 571. His second opinion is reported at 16 Fed. Supp. 778. His third opinion is reported at 31 U. S. P. Q. 195. All of these opinions, as also the opinion of the Court of Appeals, are reprinted in a pamphlet which accompanies this brief.

Here, then, are the facts as determined by the District Court and as subsequently adopted and approved by the Court of Appeals. In his first opinion, Judge Lindley said:

"Claim 2 of the Butler patent describes a lubricating system for automobiles or other machines, essentially high pressure in character, in which each bearing is provided with a headed nipple for receiving oil or grease of a lubricant compressor having a coupling member for connecting said compressor with the nipples. The coupler is slipped easily and somewhat loosely over the nipple head. As the operator pushes on the compressor, the pressure of the lubricant moves a piston within the cylinder in such manner as to cause the locking or gripping jaws to clutch or grab about or upon the nipple head. At the same time the grease under pressure acts also upon an apertured sealing seat, carried by the jaws and actuated by the piston in such a way as to engage the end of the nipple and thereby produce a tight seal. Gripping, grabbing or clutching of the nipple is effected automatically, and engagement of the seal against the end of the nipple is achieved in the same manner. Both of these functions are effectuated by the pressure of the lubricant, without other manipulation of the coupler. Thus, the coupler and nipple are so constructed as to produce an essential relationship between the two functions and the mechanism for performing them. Yet each of the two functions is carried out completely and perfectly without interference by the other. As a result, the operation is successful even though there be considerable variation in the precise dimensions in the forms and parts involved."

"Upon analysis we find that the claim includes seven elements; namely, a headed nipple, a compressor or pump, a cylinder, a piston, an opening in the piston, a sealing seat, and laterally or radially moving locking elements or jaws." (15 Fed. Supp. 571, 571.)

Regarded generically, each of these seven elements is just as old as counsel for petitioner assert the nipple to be. On the other hand, the precise conformation of the nipple whereby it is enabled to knit itself into the cooperative unit involving all of the seven elements, is just as new as each and every other element of this combination. Judge Lindley himself adverted to these facts. He said in this connection:

"Admittedly, each of these elements is old, and plaintiff makes no claim of invention because of the presence of any one of the particular elements, but insists that invention resides in a new combination of old elements so associated, related and interrelated as to accomplish a new result.

"The headed nipples are adapted to be screwed to each of the bearings of an automobile; the compressors are intended to be filled with grease and then to be coupled in succession to each of the nipples in order to inject grease into the openings of the several bearings. Consequently, the combination of the nipple, compressor, and coupler is brought together only periodically and temporarily and in the hands of the owners or servicers of the car." (15 Fed. Supp. 571, 572.)

Then, after thus setting forth that the Butler invention involved was an entirely new structure, different in construction and operation from the prior art, the District Court addressed its consideration to the opinion of this Court in the *Bassick* cases, and said:

"From an examination of the Leeds opinion I believed that the basis of the decision relative to the Gullborg patent was that this inventor of pin fitting, part of the complete combination, part of which had already been separately patented, did not bring about any new mode of operation or cooperation in or among

the other elements thereof. It did not alter or modify or give new functions to any of the other parts of the combination; and, therefore, the old parts did not participate in a new way in the accomplishment of a new and unitary result. • • •

"The ground for decision appearing in these opinions is not applicable to the Butler patent, claim 2. Here the question is whether Butler produced a combination which achieved a new and unitary result by the cooperation of all the elements, whether all the elements have new or modified functions as a result of changes or substitutions, or whether the old elements have only the old functions operating and cooperating in the old way to produce only an old result. We have seen that the combination consists of seven elements, all of which are old; that invention arises not from any one element, but from the new unitary result. Defendant insists that the essence of the combination is the coupler, but we have seen this is a fallacious theory, for if it were correct and available to excuse the use of the nipple to cooperate in the combination, one person might make the nipple, another, the cylinder; another a group of jaws, another the sealing seat; another the piston. Each of these are old; each of them sell separately. The purchaser could quickly assemble them and then claim that each part had an independent status apart from that in the Butler combination. There could then be no infringement.

"The headed nipple, which cooperates with the sealing seat and jaws of the coupler and thus with the piston and cylinder, is just as essential a part of the Butler invention as any of the several elements of the coupler. There is cooperation between the nipple and the jaws which produces the operation of the seal, which in turn effectuates the operation of the gripping jaws, making possible heretofore unachieved pressures. The headed nipple has new functions arising out of the direct co-operation with the jaws. The head spreads the jaws of the coupler when the latter is attached and thus prepares the coupler for operation in bringing about a mechanically strong and lubricant tight joint. In detaching the coupler the head of the nipple engages and pushes the jaws outwardly. These in turn push the piston backward, thereby effecting the release of the

coupler from the nipple. The presence and the action of the nipple are essential, because the nipple alone makes it possible to build up in the cylinder of the coupler a grease pressure which will force the jaws into gripping enforcement with the nipple. The nipple is not merely a receptacle. It becomes an element which coacts to influence and make possible the desired operation of the coupler mechanism.

"Butler was the first to utilize a headed nipple and a compressor as cooperating elements of a combination whereby a grease-tight and mechanically strong connection between compressor and bearing were effected automatically in and by the grease pumping operation of the compressor alone.

"The high pressure delivery of grease from the compressor to the interior of the bearing, due to the strong and grease-tight attachment of the grease gun to the grease passageway of the bearing, was a new, useful, and unitary result. It could not be accomplished with anything less than the combination of all of the elements included in Butler. Each part of the combination performed new functions and operated and cooperated in new ways in order to accomplish the single new result. The invention of Butler resides in the combination and not in one specific element. Every one of the seven old elements' functions became essential factors in the new combination. The situation is not one where the language of the Supreme Court in the Gullborg case (56 S. Ct. 787, 791, 80 L. Ed,) is applicable, for in the sense that the Supreme Court used the term pioneer, Butler is equally a pioneer. A completely new unitary result is achieved; something never accomplished before. Just as the Supreme Court said of the Berliner patent, 'each element was necessary to the operation of the other.' " (15 F. Supp. 571, 578, 578-579.)

Upon petition for rehearing, the District Court delivered a second opinion in which Judge Lindley said:

"We may well again refer to the character of the Butler patent. I have pointed out in my findings of fact and conclusions of law heretofore entered that Butler was the first to propose or devise a lubricating system in which the sealing of a joint between the end of the nipple and coupler and the mechanical grip be-

tween the nipple and coupler were achieved automatically by the pressure of the lubricant in and by the normal pumping operation of the compressor, and that the advantage of this combination arises from the fact that in the greasing of automobiles, in forcing grease into the bearing through the narrow opening of the fitting, thousands of pounds of pressure are sometimes utilized in order to remove and force out foreign bodies in the grease duct or channel. Former devices provided a seal by a screw connection between the coupler and the fitting, by a bayonet connection or by mere manual physical pressure. In all of these, some leakage occurred, and physical manipulation entailing some labor was necessary. In none of them could the pressure be exerted and the grease delivered perfectly without leakage, under desirable pressure, and with the saving of labor resulting from Butler's teaching. I previously pointed out, due to the peculiar shape of this nipple, its head and shoulders couple with the gripping jaws of the coupler in such a way that, when pressure is exerted and the grease passes from the coupler into the fitting, the coupler grabs hold of the projecting shoulder of the nipple with its jaws and automatically, as the pressure of the grease increases, simultaneously, the power, force, and closure of the connection increases, so that it is impossible for grease to escape and any desired pressure of grease may be transmitted without breakage of parts or leakage of material. All this was accomplished without further manipulation other than the easy, almost automatic, attachment of the coupler to the nipple and the application of the pressure. This, I have said, was a step forward in the greasing of automobiles. No one had ever taken it, though the art is full of grease guns and nipples. It remained for Butler to devise an easy operable combination in which the nipple and the coupler automatically cooperate, each contributing its part to the one result of high pressure grease delivery through a sealed connection, effected automatically and increasing in efficiency with the increase of the pressure. This, I said, was invention and the combination, I held, became, therefore, a pioneer invention in the sense that the Supreme Court used that word in the Leeds & Catlin case." (16 F. Supp. 778, 781.)

"So, here, Butler introduced into the art the idea of an automatic sealing connection achieved by the size and character of elements, which, in themselves, were old. But he employed a different mode of operation. He achieved his object by means of a different force and according to a different and new conception. His invention then was not an improvement but a new and separate invention and, within the reasoning of the Supreme Court in the Leeds & Catlin and the Hollingshead and Rogers cases, a pioneer. In the latter two cases the court was not dealing with a combination patent wherein, by the use of a nipple of a certain particular form and shape and dimensions cooperating with the gripping jaws of a coupler of special form and shape, an automatic unbreakable connection was achieved, making possible that highly desirable thing in automobile greasing, unlimited pressure. Butler did not combine a certain coupler with any nipple. He did not combine a certain nipple with any coupler. He was not, as the Supreme Court believed Gullborg had done, trying to extend his patent to a combination of a certain nipple with *any* kind of grease gun. Quite to the contrary, he demonstrated conception of a new creative thought, the achievement of a new valid combination in which not only the coupler was essential, but in which also the nipple of peculiar shape and dimension was essential. He produced a new combination, a new arrangement of known elements, by virtue of which he produced an entirely new and beneficial result. He developed new functions and new properties and achieved novelty, resulting in great commercial success.

"In this situation, defendant entered the field and developed its nipple of equivalent form, shape, and dimensions, which it sold, obviously, for use with Alemite guns, supplanting in the combination of Butler the nipple essential to his success. It is a striking fact that a nipple of this shape and dimension was not necessary to the operation of defendant's grease gun or of any guns other than those of plaintiff or of infringers or licensees of plaintiff—a fact of tremendous significance in determining the purposes and intent of defendant. It sold grease guns which operated with straight-headed nipples as well as with nipples with head and

shoulders. It first made straight-headed nipples and exhibited them to General Motors Corporation, but it sold to that company only nipples of infringing character, a character not essential to any combination other than plaintiff's." (16 F. Supp. 778, 782.)

In his third opinion in this same suit, his Honor Judge Lindley said in part:

"I have the conviction that this patent is valid. I have the conviction that it is being infringed and an infringement of a patent is a tort. There is a continuing tort being committed by the defendants, a tort which a Court of Equity has seen fit to enjoin and a tort which the Court believes unjustified; a tort which the Court believes, by a mere minor modification in the manufacture of one small article, could be wholly avoided, and the strange commentary—the strange fact which stares us in the face, is that the particular form of manufacture, the particular shape of this small fitting, is, in no way, a vital idea to the defendant in cooperation with its other articles of manufacture, and this peculiarly shaped fitting is the one which is adapted to plaintiff's combination. Having found that this fitting was made for the express purpose of being sold to be used with and as a part of the infringed plaintiff's combination, and having found there was no excuse for the perpetuation of that tort in the protection of the defendant's interests, I am not disposed at this time, in view of the time that has elapsed since the hearing, to grant a supersedeas. I make this statement so that it may be presented to the Court of Appeals. • • •

"I don't approve of the assignment of errors, for they put into my words something which I expressly disclaimed in my memoranda, and I don't want the Court of Appeals to be misled as to what I did hold. I have tried to make it clear in the two memoranda which I prepared in this case, and I shall not be misquoted without an expression of my disapproval of the form of the assignment of errors." (31 U. S. P. Q. 196.)

After making its expressly independent determination of the facts, and after approving and adopting Judge Lind-

ley's determination of the facts as set forth in the foregoing quotations from the three opinions of the District Court, the Seventh Circuit Court of Appeals set out to state and apply the law.

WE VENTURE TO SUGGEST THAT NO COURT HAS EVER MORE CAREFULLY, MORE ACCURATELY, OR WITH GREATER CLARITY, STATED THE LAW OF CONTRIBUTORY INFRINGEMENT AND THE LAW OF PATENTABLE COMBINATION, THAN IN THIS OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS BY HIS HONOR JUDGE EVANS.

In its opinion, the Court said:

"In the instant case, Butler does not seek to extend the monopoly of a patent for a pin fitting or to preclude the use of a grease gun in any apparatus not embodying the improvement described in the patent.

"Two questions are determinative: First, did Butler set forth a valid patentable combination when he wrote his claim No. 2? Second, did the sale of a headed nipple or a lubricant compressor made for the sole purpose of being used in connection with the apparatus made according to the Butler patent, constitute infringement?

"Combination or Aggregation. As we view claim 2 of the Butler patent, it spells combination, not aggregation. It is not the names of the various parts that determine this question. If there be coaction of elements so as to make a single unitary structure, we have a combination. The nipple head may be a non-composite apparatus. It may be the subject of a valid patent claim. Likewise, it may be part of a combination.

"In the instant case, it is conceded that the headed nipple was not patented. More, it is not patentable. It will be assumed that it was old. Nevertheless, if it is an element in an otherwise valid combination (due to the novel coupling method), it is a unit of said combination and a third party supplying it, if other necessary facts are shown, may thereby infringe.

"Whether the supplier of headed nipples or other elements of the combination set forth in claim 2 is a contributory infringer depends first on whether the

element supplied is a part of a valid combination (as distinguished from an aggregation), and second, on whether the producer so constructs it that it can be said that it was knowingly made with the intention that it would be used in connection with the patented combination.

"There is an exception to this statement—If an element of a patented combination in the very nature of its use wears out and a new one is supplied, it may be furnished without the producer's infringing. *Heyer v. Duplicator Mfg. Co.*, 263 U. S. 100; *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 325. But, where the intent is present, as here, to supply separate units of a patented combination and not as a renewal of a wornout part, contributory infringement is disclosed.

"The findings of the District Court on this question respecting the dimensions of appellant's headed nipple clearly show an intention to make parts which could only be used in connection with the patented combination. If, then, the Butler claim No. 2 disclosed a valid combination, infringement was shown.

"In dealing with this subject of contributory infringement, it might be observed that we are dealing with a phase of the general subject of torts. An infringer is a tortfeasor. A contributory infringer is one whose action contributes to the infringement.

"Because of the statute, the owner of a patent is entitled to exclude others from making, selling, or using the patented product. Violation of any of these rights makes the violator a tortfeasor, an infringer. Making, buying or selling a non-patented article is not of itself infringement. It only becomes so when said maker, seller or user does so knowing that the non-patented element is to be used in connection with other elements in a valid combination covered by a valid patent. This is the doctrine on contributory infringement.

"In the instant case, the court has made findings, and the facts leave no doubt as to the soundness of such findings, to the effect that the non-patented parts made by appellant were not only intended for use in connection with Butler's patented combination but they could hardly be used otherwise. The size and dimensions of the fittings most conclusively demonstrate this fact.

"It might be asserted that appellant did not infringe when it *manufactured* one element of the product for it could have been sold to one who would use it other than in the Butler patent combination. However, when it appears that such products were made by the appellant and sold to garages and it further appears that the fittings were of such measurement as to preclude their use except on appellee's patented apparatus, contributory infringement both in selling and in using is established.

"To establish contributory infringement the following facts must appear: (1) a valid patent; (2) ordinarily in the case of a product patent covering a combination; (3) the alleged infringer must make or supply one or more of the elements of the combination with the knowledge and intention that the same is to be used in the patented combination.

"Contributory infringement is the outgrowth or result of the application of the following legal propositions:

"(1) A patentable combination is a unit in the contemplation of the law.

"(2) Some elements of the combination may be old and others new, or all old, or all new.

"(3) One who makes, sells or uses the combination without permission of the patentee is an infringer.

"(4) One may be a contributory infringer although he makes, sells or uses an element that is old and not covered or coverable by a patent.

"(5) When the manufacturer makes, uses or sells an unpatented (an old) element, he becomes a contributory infringer only when the element is knowingly made, sold or to be used as a part of a patentable combination without patentee's express or implied consent.

"(6) Implied consent exists when in the ordinary use of the patentable combination one element constantly and frequently wears out and must be replaced. *Heyer v. Duplicator, supra.* Whether there is a consent is often a fact issue, but not involved in the instant suit.

"In the last analysis this question of contributory infringement in the instant suit must be determined by the existence or absence of a valid combination wherein one of the essential elements was a product made

by appellant. If the elements do not spell a combination, but are merely an aggregation, there is of course no contributory infringement.

"For obviously, infringement can exist only when there is a valid patent. No valid patent can cover a group of elements which are correctly termed an aggregation and which do not conform to the correct legal definition of a combination. There is a valid combination only when the element—headed nipple—co-acts with the lubricant, compressor and the coupling member. If two of these elements do not co-act and the third element does not likewise co-act with one of the other two members, we do not have a case of valid combination."

"Doubt over this issue can only arise when one of the elements may in itself serve a multiple of purposes. It may be used outside the combination of the patent. If so, its use is valid and legitimate. The determining fact issue is the intent and the purpose it serves, and was intended to serve when made or sold. If made, sold or used as an intended element in the combination which is the basis of the patent claim, it is a case of contributory infringement, otherwise not." (91 F. (2d) 757, 762-764.)

In further exposition of the law as understood and applied by the Seventh Circuit Court of Appeals to the facts of the instant suit as determined by it, Judge Evans, in his opinion, said:

"If the (Supreme) court announced a rule in the Bassick case as contended by appellant's counsel, or if all of its implications (the substitution of a new element for an old element does not afford the basis of a valid patent) be accepted as the present law respecting the validity of patents then *Leeds & Catlin v. Victor Talking Machine Co.*, 213 U. S. 301, is overruled. However, instead of stating that the Leeds & Catlin opinion is overruled, the court distinguished it and thereby impliedly recognized the soundness of the rule there announced.

"Until and unless there is an express repudiation of the *Leeds & Catlin v. Victor Talking Machine Co.* case, we can not accept the *Bassick v. Hollingshead* opinion

as being inconsistent with the views stated in the former opinion. In other words, we must apply to the instant case the rules of law which govern and apply the tests which have long been applied to determine whether the Butler combination is a patentable invention.

"In dealing with product patents and their validity it might be observed that the word 'combination' is somewhat unfortunate. A combination contemplates a plurality of units, yet patentable invention can only reside in a combination when it (the combination) is *considered as a unit*. For convenience's sake, courts speak of elements in a combination as units in and of themselves. It is only for the sake of convenience that reference is made to such *elements* as 1, 2, 3, 4 and 5. Each and every valid claim of a patent covers a *unit*, although in a combination claim the unit may have five parts or elements. When we so consider a claim it is clear that one unit must differ from another unit if one element, say element three in one combination is different from element three in another combination. To illustrate: If one mixes five different colored paints in stated proportions, he would have a product which might be denominated X. X must be viewed as a unit. If the same individual mixed in the same proportions five different colored paints, four of which were similar to the ones in the first combination but one was different, the final product would not be the same. In testing the validity of any machine or product patent, then, whether it be what is commonly called a combination, or a single, a non-composite substance, the following propositions may be accepted as sound:

"1. All the elements may be old but if they have never appeared together in combination and they coact so as to avoid the charge of aggregation, the unit *may* constitute a valid claim of a patent.

"2. Where a combination consists of five elements—1, 2, 3, 4, and 5—and the inventor uses four old elements—1, 2, 3, and 5,—in the same way and for same purpose as in the previous combination, but substitutes a new element 4 for old element 4 of the old combination and obtains desirable results, the new combination may be the subject of a valid claim. It is not anticipated by the previous combination.

"3. Likewise, one may substitute for element 4 an old and well-known element but which has never been used in combination with elements 1, 2, 3, and 5, and these elements being presented in the new combination for the first time may be the subject of a valid patent.

"In stating these propositions, we have used the word '*may*' for there are other factors to be considered in determining patentability. For instance, the novelty may not be patentable. The advance may represent the skill of the artisan or the mechanic, not the genius of the inventor. Perhaps it would be better to say that the objection that the combination is lacking in novelty is not sound under the conditions enumerated.

"Equally clear is the law which denies to anyone the right to repatent an old combination.

"Accepting the foregoing principles as sound and applying them to the instant case, we have no difficulty in distinguishing any of the prior art. Nor are we troubled by the decision in the Bassick case. The Butler coupling member and his nipple head are novel. Their structures are clearly distinguishable from the prior art. Whether the other mentioned elements are old is immaterial.

"The only validity questions left relate to combination as distinguished from aggregation and the character of the discovery—whether it marks patentable novelty or mechanical skill. In passing, it might be observed that if a new product is found to be patentably novel, it is immaterial whether said patentable novelty is of the pioneer type or 'the mere improvement type' of invention." (91 F. (2d) 757, 761-762.)

Compare this exposition of the law in Judge Evans' opinion for the Seventh Circuit Court of Appeals, with those famous and now classic statements of the law which were cited and reaffirmed by this Court in its decision of the Rogers and Hollingshead cases!

The opinion of the Seventh Circuit Court of Appeals will not be found to be lacking in insight or in clarity or in accuracy or in conformity.

We refer, of course, to the two notable passages in the opinions of this Court by Mr. Justice McKenna in the two cases of *Leeds & Catlin v. Victor*. In the first of these opinions the Court said:

"A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under the same cooperative law. Certainly, one element is not the combination nor in any proper sense can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of the patent laws. It is in accordance with the policy of Sec. 4887 of the Revised Statutes, which is urged against it." (Emphasis ours.)

Leeds & Catlin v. Victor, 213 U. S. 301, 318.

The second of these classical statements of the law is to be found in the opinion in the second case of *Leeds & Catlin v. Victor* (No. 2), 213 U. S. 325, 332. Here Mr. Justice McKenna said:

"A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or non-composite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its

elements or all of its elements are unpatented. For instance, in the case at bar the issue between the parties would be exactly the same, even if the record disc were a patented article which petitioner had a license to use or to which respondent had no rights independent of his right to its use in the combination. In other words, the fact that the disc sold by petitioner is unpatented does not affect the question involved except to give an appearance of a limitation of the rights of an owner of a Victor machine other than those which attach to him as a purchaser. The question is, What is the relation of the purchaser to the Victor Company? What rights does he derive from it? To use the machine, of course, but it is the concession of the argument of petitioner that he may not reconstruct it." (Emphasis ours.)

The opinion of the Seventh Circuit Court of Appeals, when matched against these classics, will not be found to be lacking on the score of clarity. The opinion of the Court of Appeals has indeed the advantage of concrete amplification and exemplification.

Upon this petition for a writ of certiorari, the important consideration is, of course, that the Seventh Circuit Court of Appeals has stated the law which it applied to the facts of the present case. It stated the law in such a way that no one can be heard to challenge it.

NOT EVEN COUNSEL FOR THE PETITIONER ADVANCE A SINGLE WORD IN CRITICISM OF THE LAW AS FULLY AND EXPLICITLY STATED IN THE OPINION OF THE SEVENTH CIRCUIT COURT OF APPEALS.

It is perhaps a sufficient answer to the petition for the writ of certiorari that not even counsel for the petitioner advance a single word in criticism of the law as stated in the opinion of the Seventh Circuit Court of Appeals. Counsel do not even refer to the explicit statement of the law which the Seventh Circuit Court of Appeals said that it applied to the facts of the instant case.

IT IS ONLY BY ASSUMING THAT THE FACTS ARE AS STATED BY COUNSEL FOR THE PETITIONER RATHER THAN AS STATED BY THE COURT OF APPEALS THAT COUNSEL PUT THEMSELVES IN POSITION TO ASSERT, AS THEY DO, THE CONCLUSION THAT THE COURT OF APPEALS HAS RENDERED A DECISION WHICH IS "IN DIRECT CONFLICT" WITH BOTH THE RECENT DECISIONS OF THIS COURT AND THE EARLIER DECISIONS OF THIS AND OTHER FEDERAL COURTS ON A POINT OF LAW.

The attack by counsel for the petitioner seeks to gain the advantage of a flanking movement. Counsel say that the facts of the instant case are utterly at variance with those which were explicitly determined, adopted, and stated by the Court of Appeals. It is only by assuming that the facts are as stated by counsel for the petitioner rather than as stated by the Court of Appeals, that counsel put themselves in position to assert, as they do, the conclusion that the Court of Appeals has rendered a decision which is "in direct conflict" with both the recent decisions of this Court and the earlier decisions of this and other federal courts on a point of law. (Petitioner's Brief, p. 48.)

WHAT ARE THE FACTS? THAT IS THE SOLE QUESTION.

Are the facts such as are asserted by counsel for the petitioner?

Or are the facts such as determined and stated by the Court of Appeals?

That, in the final analysis, is the sole question which counsel for the petitioner seek to have reviewed by this Court upon a petition for a writ of certiorari.

RELATIVE TO THE PETITIONER'S "POINT III" VARIANT OF ITS "POINT II" CONTENTIONS.

The Court will find it difficult to determine just what constitutes the grounds alleged for the grant of the writ of certiorari.

At the outset of their petition, counsel state three grounds, *i. e.*, an alleged conflict with the decision of the Eighth Circuit Court of Appeals, an alleged conflict with a decision by the United States District Court for the Western District of Pennsylvania, and an alleged conflict with the decision of this Court in *Rogers v. Alemite*. (Petition, p. 2.)

When they come to state the "Reasons Relied Upon for Allowing a Writ of Certiorari," on page 19 of their petition counsel do not rely at all upon the alleged conflict with the decision of the District Court for the Western District of Pennsylvania. They refer to it only parenthetically and by way of persuasion relative to the alleged conflict with the decision of this Court in *Rogers v. Alemite*.

Into the "Reasons Relied Upon," counsel for the petitioner have, however, interjected a new contention, namely, an allegation that the Seventh Circuit Court of Appeals "has decided an important question of federal law in a way which is untenable and in conflict with the weight of authority."

The "Reasons Relied Upon" then assert "an erroneous decision in the case at bar on an important question of federal law in direct conflict with Sec. 3 of * * * the Clayton Act," and also that the decision of the Circuit Court of Appeals "goes to the broad and general question of implied license by estoppel."

When we come to the brief in support of the petition, we find on page 37 the quotation:

"ARGUMENT OF POINT III."

"Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease cup, pump and coupler; whereas patentee's improvement, if any, is merely in the assertedly improved coupler."

It is difficult to align this "Point III" with any of the grounds stated at the outset of the petition.

Addressing ourselves, however, to the "Point III" as it appears on pages 37 to 42 of the petitioner's brief, it is to be noted at the outset that this is another of the "in effect" contentions. It is said that,

"The Court of Appeals for the Seventh Circuit in the case at bar has erroneously held, *in effect*, that one who invents an improvement in one device normally useful in conjunction (or in an old combination) with other devices of the prior art, need not content himself with merely claiming his assertedly improved device, *per se*, but may validly claim his improved device in the old combination where it is normally to be used."

It is obvious that the assertion and argument of this "Point III" must hinge, and by the phraseology in which it is stated almost concededly hinges, upon the assertion that the facts are wholly different from those which were determined by the Seventh Circuit Court of Appeals and then made the basis of its decision under the law applicable to the determined facts.

In our discussion of the petitioner's "Point II", we have sufficiently contrasted the facts as determined by the Seventh Circuit Court of Appeals with the facts asserted on behalf of the petitioner. It will be unnecessary to recanvass them in connection with this third point variant of the petitioner's "Point II" contention.

Again the sole question is, What are the facts?

If the facts are such as were determined by the Seventh

Circuit Court of Appeals, then nobody can find fault with the law relied upon by the Seventh Circuit Court of Appeals in reaching its conclusion. Not even counsel for the petitioner have the hardihood to say that the Seventh Circuit Court of Appeals stated any such idea of the law as that which counsel first abstractly formulate and then complain of. Here again they say that the Seventh Circuit Court of Appeals "*in effect*" held so-and-so and so-and-so as intriguingly phrased by counsel for the petitioner.

What are the facts! What are the facts! That is the only real question which the petitioner seeks to have determined by this Court. Everyone knows and accepts and accurately states the law.

Did the Seventh Circuit Court of Appeals accurately determine the facts! That is the sole question which the petitioner would like to have answered by this Court.

UNDER POINT IV-a THE PETITIONER SEEKS TO SECURE A DE NOVO CONSIDERATION AND DECISION OF THIS COURT RELATIVE TO ALLEGED VIOLATIONS OF THE CLAYTON ACT, —A DEFENSE WHICH WAS NEVER PLEADED, NEVER OFFERED, NEVER URGED, NEVER CONSIDERED, NEVER DECIDED, NEVER MENTIONED, THROUGHOUT ALL OF THE PROCEEDINGS IN THE LOWER COURTS. IT NOW APPEARS FOR THE FIRST TIME AND YOUR HONORS ARE INVITED TO DECIDE THE CONTENTION WITHOUT HAVING THE BENEFIT OF ANY EVIDENCE BY ANY PARTY.

In view of the confusion between the petition and the brief in support of it, let us say that we refer here to the petitioner's "Point IV-a" as it appears on page 42 of the brief in support of the petition. It is with the two branches of this "Point IV" that counsel for petitioner conclude their petition for certiorari. In the petition, they reiterate their grounds for the issuance of the writ as theretofore discussed, concluding with a fourth asserted ground set forth in three pages. This is to the effect that the decision sought to be reviewed is

"an erroneous decision in the case at bar on an important question of federal law in direct conflict with Sec. 3 of the Act of Oct. 15, 1914; 33 Stat. L. 731, known as the Clayton Act, and in direct conflict with applicable decisions of this Court on the same matter, and in direct conflict with the applicable decisions of other Circuit Courts of Appeals, and in direct conflict with the applicable earlier decision of the same Court (C. C. A. 7) on the same matter."

This sweeping barrage behind which petitioner seeks to crawl into this Court is without any foundation or support in the record. No such issue was raised by the pleadings in the District Court (R. 7-10, 16-18, 26-29), or by the twenty-three assignments of error upon which the appeal was taken (R. 444-450), or in one hundred and fifty pages of argument filed in the Circuit Court of Appeals, or in the elaborate petition for rehearing filed in the Circuit Court of Appeals and incorporated in the record before this Court (R. 647-718). No such issue is mentioned or disposed of in any of the four opinions filed by the District Court and the Circuit Court of Appeals in this case.

This specious assertion of a nonexistent reason for the issuance of a writ of certiorari is well in character with the remainder of the case as presented by the petition.

THE PETITIONER'S POINT IV-b IS THAT THE LINCOLN COMPANY WAS IMPLIEDLY LICENSED TO SELL THE VARIOUS PARTS OF THE BUTLER INVENTION. THE DEFENSE OF LICENSE CANNOT BE MADE UNLESS PLEADED. IT WAS NEVER PLEADED, NEVER SUGGESTED, NEVER URGED, NEVER CONSIDERED, NEVER DECIDED, NEVER MENTIONED PRIOR TO THE ADVENT OF THIS PETITION IN THE SUPREME COURT. PETITIONER IS ASKING FOR A DE NOVO CONSIDERATION AND DECISION UPON A CONTENTION RELATIVE TO WHICH NO PARTY HAS OFFERED ANY EVIDENCE WHATSOEVER.

The petitioner's argument of this point first appears on page 42 of the brief in support of the petition. The contention is otherwise stated on page 23 of the petition.

The contention is that the defendant, Lincoln Engineering Company, was impliedly licensed to sell the headed nipple part of the Butler invention.

Neither the original answer nor any amendment to any answer pleads an implied license or any license as a defense. The issue was not raised by any pleading in the District Court. (R. pp. 7-10, 16-18, 26-29.) The contention was not raised by any of the twenty-three assignments of error upon which an appeal was taken to the Seventh Circuit Court of Appeals. (R. 444-450.) No mention of the implied license defense was made in 150 pages of argument filed by the petitioner in the Circuit Court of Appeals. No mention of an alleged license of any kind was made in the elaborate petition for rehearing filed in the Circuit Court of Appeals. (R. pp. 647-718.)

The three opinions of the District Court and the opinion of the Court of Appeals bear internal evidence of the care and thoroughness with which they undertook to state and decide every question in issue. They can be searched in vain for any reference to the contention of an implied license.

**IN GENERAL, RELATIVE TO THE PETITIONER'S POINTS IV-a
AND IV-b.**

It is well settled that alleged violations of the Clayton Act may not be interposed as a defense to a patent infringement suit. Even if such violations could be made a matter of defense, they certainly must be pleaded as such.

The law is well settled that an alleged license must be explicitly pleaded as a matter of defense.

It goes without saying that if these defenses were to be relied upon, the parties should have had an opportunity to adduce evidence addressed to the contentions. The record

is barren of any evidence by either party relative to these new contentions which are now advanced in this Court for the first time.

The petitioner is asking this Court to go into these contentions *de novo*, and to decide for the first time the questions which are thus raised. Your Honors are asked to decide these questions upon a record in which the alleged defenses were never pleaded, never made the subject of any evidence, never advanced to the lower courts, never considered by them, never decided by them.

We submit that a petition for a writ of certiorari does not provide the channel through which to secure a *de novo* adjudication of such contentions as are here advanced for the first time.

IN CONCLUSION.

It is evident that what petitioner seeks by its petition is to secure a complete review of a simple patent case decided upon facts and upon law as to which there is no conflict of decisions either between Circuit Courts of Appeals or between the Seventh Circuit Court of Appeals and this Court.

In more than eighty pages in which the petition is presented and argued, no conflict is disclosed. No contention warrants the issuance of the writ of certiorari.

It is, therefore, respectfully submitted that the petition should be denied.

Respectfully submitted,

LYNN A. WILLIAMS,

Counsel for Respondent.

December 20, 1937.

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